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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,284	11/23/1999	QINGHONG CAO	CAO-2-2-11-1	3630

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EXAMINER

LY, NGHI H

ART UNIT	PAPER NUMBER
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2617

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04/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/447,284	Applicant(s) CAO ET AL.	
	Examiner NGHI H. LY	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,9,10,14,15,19,20,24,25,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) 14,15,24,25 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9,10,19,20 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14,15,24,25 and 28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.

Election/Restrictions

2. Applicant's election with traverse of Specie I (claims 1, 2, 4, 5, 9, 10, 19, 20 and 29) in the reply filed on 02/04/08 is acknowledged. The traversal is on the ground(s) that the Examiner has already considered each of the unelected claims multiple times over these years. Restriction at this late stage in the prosecution is improper. This is not found persuasive because the species are patentably distinct:

Species I, including claims 1, 2, 4, 5, 9, 10, 19, 20 and 29 relate to muting the music.

Species II, including claims 14 and 24, relate to the downloaded digital bit stream music comprised in an MPEG format is stored in Flash memory in said remote handset.

Species III, including claims 15 and 25, relate to wherein the remote bit stream audio source is accessible by said remote handset via an Internet.

Species IV, including claim 28, relate to means for decompressing MPEG formatted music into digital music samples for digital to analog output.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 9, 19 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1, 9, 19 and 29, the newly added limitation in claims recite “a synthesized ring tone is summed with an MPEG audio bit stream”. However, the specification page 13, second paragraph discloses “a synthesized tone may be summed with the MP3 digital audio bit stream”.

Therefore, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 2, 4, 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP07212829A) in view of Borland et al (US 6,556,965) and further in view of Young, III (US 5,694,467).

Regarding claims 1 and 29, Sato teaches a cordless telephone (see Title and Abstract), comprising: a remote handset (see Drawing handset 37), a base unit

matched to the remote handset (see Drawing base unit 24), and an audio player integrated within at least one of the remote handset and the base unit (see Title, Abstract and Detailed Description).

Sato does not specifically disclose an MPEG audio integrated within at least one of the remote handset and the base unit.

Borland teaches an MPEG audio integrated within at least one of the remote handset and the base unit (see Abstract, column 5, lines 37-40, column 4, lines 7-21, "MP3", and column 4, lines 48-66, "MPEG" and "MP3", also see column 3, line 65 to column 4, line 7, "MPEG" and see column 5, lines 24-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose a synthesized ring tone is summed with an MPEG audio bit stream, a user of the telephone may initiate an action to mute music playing from the audio when the telephone receives a telephone call.

Young teaches a synthesized ring tone is summed with an MPEG audio bit stream (see Abstract and column 2, lines 9-24, see "a user headset is connected to a mixer with audio input from a Music Source, a mic detecting ambient noise, and a ring tone from the phone"), a user of the telephone may initiate an action to mute music playing from the audio when the telephone receives a telephone call (see column 2, lines 25-41 and Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Young into the system of Sato and Borland in order to improve in sound headset systems and telephone headset systems (see Young, column 1, lines 7-9).

Regarding claim 2, the combination of Sato, Borland and Young teaches the MPEG audio player is integrated within the remote handset (see Sato, Title, Abstract and Detailed Description, and see Borland, column 5, lines 24-28).

Regarding claims 4 and 5, the combination of Sato, Borland and Young further teaches the MPEG audio player is an MP3 (see Borland, Abstract, "MP3", column 4, lines 7-21, "MP3").

8. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (JP07212829A) in view of Borland et al (US 6,556,965) and further in view of Tuoriniemi et al (US 5,978,689) and Young, III (US 5,694,467).

Regarding claims 9, 10, 19 and 20, Sato teaches a method of integrating an MPEG audio player in a cordless telephone (see Title and Abstract) comprising: playing of the pre-loaded music from the remote handset of a cordless telephone (see Title, Abstract and Detailed Description), connecting a base unit of the cordless telephone to a public switch telephone network (the base unit of cordless telephone of Sato inherently connect to a public switch telephone network).

Sato does not specifically disclose a method of integrating an MPEG audio player in a cordless telephone and playing of the pre-loaded MP3.

Borland teaches a method of integrating an MPEG audio player in a cordless telephone and playing of the pre-loaded MP3 (see column 5, lines 24-28 and column 4, lines 27-33, see "storage in portable systems" and column 4, lines 43-47, see "playback").

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Borland into the system of Sato in order to provide high quality audio signal (see Borland, Abstract).

The combination of Sato and Borland does not specifically disclose muting the playing of the pre-loaded music when the remote handset is active in a current telephone call.

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Tuoriniemi into the system of Sato and Borland so that the user won't miss the telephone call while enjoy listening to music.

The combination of Sato, Borland and Tuoriniemi does not specifically disclose a synthesized ring tone is summed with an MPEG audio bit stream, muting the playing of the music by an action initiated by a user.

Young teaches a synthesized ring tone is summed with an MPEG audio bit stream (see Abstract and column 2, lines 9-24, see "a user headset is connected to a

mixer with audio input from a Music Source, a mic detecting ambient noise, and a ring tone from the phone”), muting the playing of the music by an action initiated by a user (see column 2, lines 25-41 and Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Young into the system of Sato, Borland and Tuoriniemi in order to improve in sound headset systems and telephone headset systems (see Young, column 1, lines 7-9).

Response to Arguments

9. Applicant's arguments filed 11/02/07 have been fully considered but they are not persuasive.

On page 9 of applicant's remarks, applicant argues that these references, either alone or in combination, fail to teach or disclose summed with an MPEG audio bit stream, and muting the playing of MP3 music by the user initiating an action when the cordless telephone receives a telephone call, as recited by claims 1, 2, 4, 5 and 29.

In response, Sato teaches a cordless telephone (see Title and Abstract), comprising: a remote handset (see Drawing handset 37), a base unit matched to the remote handset (see Drawing base unit 24), and an audio player integrated within at least one of the remote handset and the base unit (see Title, Abstract and Detailed Description).

Borland teaches an MPEG audio integrated within at least one of the remote handset and the base unit (see Abstract, column 5, lines 37-40, column 4, lines 7-21,

“MP3”, and column 4, lines 48-66, “MPEG” and “MP3”, also see column 3, line 65 to column 4, line 7, “MPEG” and see column 5, lines 24-28).

Young teaches a synthesized ring tone is summed with an MPEG audio bit stream (see Abstract and column 2, lines 9-24, see “a user headset is connected to a mixer with audio input from a Music Source, a mic detecting ambient noise, and a ring tone from the phone”), a user of the telephone may initiate an action to mute music playing from the audio when the telephone receives a telephone call (see column 2, lines 25-41 and Abstract).

Therefore, the combination of Sato, Borland and Young does indeed teach applicant’s claimed limitations. In addition, applicant’s attention is directed to the teaching of Sato, Borland and Young above.

On pages 9 and 10 of applicant’s remarks, applicant further argues that these references, either alone or in combination, fail to teach or disclose summed with an MPEG audio bit stream, and muting the playing of MP3 music by the user initiating an action when the cordless telephone receives a telephone call, as recited by claims 9, 10, 19 and 20.

In response, Sato teaches a method of integrating an MPEG audio player in a cordless telephone (see Title and Abstract) comprising: playing of the pre-loaded music from the remote handset of a cordless telephone (see Title, Abstract and Detailed Description), connecting a base unit of the cordless telephone to a public switch telephone network (the base unit of cordless telephone of Sato inherently connect to a public switch telephone network).

Borland teaches a method of integrating an MPEG audio player in a cordless telephone and playing of the pre-loaded MP3 (see column 5, lines 24-28 and column 4, lines 27-33, see “storage in portable systems” and column 4, lines 43-47, see “playback”).

Tuoriniemi teaches muting the playing of the pre-loaded music (see column 9, lines 17-20) when the remote handset is active in a current telephone call (see column 7, lines 49-55).

Young teaches a synthesized ring tone is summed with an MPEG audio bit stream (see Abstract and column 2, lines 9-24, see “a user headset is connected to a mixer with audio input from a Music Source, a mic detecting ambient noise, and a ring tone from the phone”), muting the playing of the music by an action initiated by a user (see column 2, lines 25-41 and Abstract).

Therefore, the combination of Sato, Borland and Young does indeed teach applicant's claimed limitations. In addition, applicant's attention is directed to the teaching of Sato, Borland, Tuoriniemi and Young above.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NGHI H. LY whose telephone number is (571)272-7911. The examiner can normally be reached on 9:30am-8:00pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly

/Nghi H. Ly/
Primary Examiner, Art Unit 2617